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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/181,108	10/28/1998	BENJAMIN L. MILLER	176/60440-(1	9507

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EXAMINER

CELSA, BENNETT M

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# **Advisory Action**

Application No.  
**09/181,108**

Applicant(s)  
**Miller et al.**

Examiner  
**Bennett Celsa**

Art Unit  
**1627**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jan 15, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Sep 24, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☒ they raise the issue of new matter. (See NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See Attachment

4. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_  
\_\_\_\_\_
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1-7, 10, and 41
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
11. ☐ Other:

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*Advisory Action Cont.*

*Reasons for Nonentry:*

1. The term “which exists at equilibrium” introduces the issue of new matter since applicant has not indicated where specification support exists for this term.
2. The term “three or more non-biopolymer ligands” introduces the issue of new matter since applicant has not indicated where specification support exists for this term. Additionally, the carving out of a new subgenus raises the issue of new matter.
3. The introduction of the term “three or more non-biopolymer ligands” appears to be addressed to a nonelected invention since the elected species encompasses metal (and/or ions) which contain *only two* different non-biopolymer ligands (e.g. see Applicant's election without traverse of the species of bis-N-[2-(2-aminomethyl)-1-methyl pyrrolidine]salicyladimate Zinc II in Paper No. 13 which reads on claims 1-7 and 10 ).
4. The recitation of “three or more non-biopolymer ligands” (e.g. in the preamble) and the further recitation of “at least two non-biopolymer ligands” in the body of the claim raise indefinite issues under 35 USC 112, second paragraph which may require the raising of a new rejection.
5. The bifurcated nature of the preamble and the body of the claim introduces both new matter and indefinite issues (e.g. regarding what portion of the claim delineates the library). The claim appears to claim both a library and a plurality and its unclear as to what the metes and bounds of the claim is and whether the claim recites both a generic and specific embodiment in the same claim.

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6. The new claim may necessitate the rewriting of prior art rejections already of record to address the new scope (or variable scope: see item 5 above) of amended claim 1.
7. For all the reasons recited above (e.g. items 1-6) the after-final amendment would necessitate both additional search and additional consideration.
8. For all the reasons recited above (e.g. items 1-7) the after-final amendment would not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. (It is noted, however, that the after-final amendment appears to address the new matter rejection of the term "target molecule".
9. There is no reason why the after-final amendment was not earlier presented.

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothisna Venkat (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

March 3, 2002

**BENNETT CELSA  
PRIMARY EXAMINER**

